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Brian J. Cragun

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EXAMINER

PONIKIEWSKI, TOMASZ

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/691,287	Applicant(s) CRAGUN ET AL.	
	Examiner Tomasz Ponikiewski	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-24, 26, 27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-24, 26-27, 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed on June 21, 2006 has been received and entered. Claims 1-8, 25 and 28 have been canceled therefore claims 9-17, 24 and 27 are pending.
2. The Applicant's communication overcomes the double patenting issue, as well as some objections and rejections under 112 and 101.

Claim Objections

3. Claims 9, 11-12, 17, 19, 20, 24, and 26-27 are objected to because of the following informalities:

Claims 9, 12, 17, 24, and 27 objected to because of the following informalities: the recitation of "only if" makes the statement(s) following the recitation totally optional. As such the action does not have to occur. The examiner suggests using "when" instead. Appropriate correction is required.

Claims 20 and 27 recite the word "for" in the claims. It indicates intended use and as such does not carry patentable weight. The word could be changed to recite "to". The limitations following the phrase "for" describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase "for" do not carry patentable weight, which cause the claims to appear as a series of non-

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functional descriptive material/data without any functional relation with each other.

Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

Claims 9, 17, 19, 24, 26-27, and 29 recite, "allowing" or "allow". Allowability does not mean that the step is being accomplished. It suggests a capability but not necessarily taking place. It should be amended to recite definite language i.e. "configured" or "to".

Claim 26 introduces "an interface". An interface is provided in parent claim 24. Is the recitation in claim 26 new instance of a different interface or is it the same interface in both claims. If it is the same interface then the recitation is possible rejection for no antecedent basis.

Claim 11 states the intended use by use of word "using". To overcome this type of rejection, claims could be amended to recite definite functionality (i.e. "based on")

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 24 rejected for not having support for "tangible" medium. To amend the claim, the word "tangible" should be deleted. To meet the requirement "computer-readable storage medium" is enough.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 17, 24 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 17 recite "second view of data" in the body of the claims. The claims do not show how this view is obtained or what is meant by second view.

Claim 24 state "for associating" in the preamble. The body of the claim never actually does the associating. There is no nexus between preamble and body of claim and it does not achieve the intended use of structuring data as recited in preamble.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 17, and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 17, and 24 list computational steps in a program without tangible, useful, concrete result. The claims do not have any visible result or output. The steps of "indicating" are missing real world result. Indicating doesn't actually have show or output the result of determination. There needs to be an outputting or storing for further use.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 9-10, 12-22 and 24, 26-27, 29-30 rejected under 35 U.S.C. 102(e) as being anticipated by Bays et al. (US 2003/0018632).

As per claim 9 Bays et al. is directed to a computer implemented method for providing an indication of an annotation to a portion of a first view of data, comprising:

providing an interface allowing display of a second view of data (figure 2 shows "interface" with icons, rows and columns and different view button; page 3, paragraph 0038, lines 7-9, wherein "second view" means "views");

analyzing the second view of data to identify sub-objects visible in both the second view of data and the annotated portion of the first view of data (figure 2 shows "interface" with icons, rows and columns; page 3, paragraph 0038, lines 10-16);

and providing an indication of the annotation in the interface, only if a predetermined set of sub-objects visible in the second view of data are visible in the annotated portion of the first view of data (page 3, paragraph 0038, lines 10-19).

As per claim 10 Bays et al. is directed to analyzing the second view of data to identify sub-objects visible in both the second view of data and the annotated portion of the first view of data comprises:

obtaining a set of sub-object links stored with the annotated (page 3, paragraph 0038, lines 14-15);

and identifying sub-objects identified by the sub-object links that are visible in the second view of data (figure 2 shows "interface" with icons, rows and columns; page 3, paragraph 0038, lines 14-19).

As per claim 12 Bays et al. is directed to providing an indication of the annotation in the interface only if each sub-object visible in the annotated portion of the first view of data is visible in the second view of data (figure 2 shows "interface" with icons, rows and columns; page 2, paragraph 0017, lines 22-29).

As per claim 13 Bays et al. is directed to providing an indication of the annotation in the interface comprises displaying an icon proximate one or more sub-objects visible in the second view of data that are also visible in the annotated portion of the first view of data (figure 2 shows "interface" with icons, rows and columns).

As per claim 14 Bays et al. is directed to more than one annotation is associated with one or more portions of data in the second view and separate icons for each annotation are displayed (figure 2 shows "interface" with icons, rows and columns; page 2, paragraph 0017, lines 27-29).

As per claim 15 Bays et al. is directed the method further comprises displaying the annotation in response to a user selecting the icon (page 4, paragraph 0051, lines 3-9).

As per claim 16 Bays et al. is directed to providing an indication of one or more sub-objects visible in the second view of data that are also visible in the annotated portion of the first view of data (figure 2 shows "interface" with icons, rows and columns; page 4, paragraph 0055, lines 1-3).

As per claim 17 Bays et al. is directed to a computer implemented method of creating and displaying an annotation associated with an annotated portion of a first view of data, comprising:

providing an interface allowing selection of the annotated portion of the first view of data and creation of the annotation, wherein the annotated portion comprises at least two cells visible in the first view of data (figure 2 shows "interface" with icons, rows and columns; page 4, paragraph 0050, lines 7-9, wherein "reference" means "annotation"; page 4, paragraph 0053);

creating a record containing the annotation and a link to each cell in the annotated portion (page 2, paragraph 0020, lines 1-9);

presenting a second view of data (figure 2 shows "interface" with icons, rows and columns and different view button; page 3, paragraph 0038, lines 7-9, wherein "second view" means "views");

analyzing the second view of data to identify cells visible in both the second view of data and the annotated portion of the first view of data (page 3, paragraph 0038, lines 10-16);

and providing an indication of the annotation, only if a predetermined set of cells visible in the second view of data are visible in the referenced portion of the first view of data (page 2, paragraph 0017, lines 22-29).

As per claim 18 Bays et al. is directed to the predetermined set of cells comprises at least one of:

- all the cells visible in the annotated portion of the first view of data (figure 2);
- a predetermined number of cells visible in the annotated portion of the first view of data (figure 2);
- a specified set of cells visible in the annotated portion of the first view of data (figure 2);
- and a predetermined percentage of cells visible in the annotated portion of the first view of data (page 2, paragraph 0022, lines 5-7).

As per claim 19 Bays et al. is directed to the predetermined set of cells is specified by a user via the interface allowing selection of the annotated portion of the first view of data and creation of the annotation (page 2, paragraph 0020).

As per claim 20 Bays et al. is directed to providing a mechanism for identifying the predetermined set of cells, wherein the mechanism is accessible by a human user or a software application (page 2, paragraph 0022, lines 5-7).

As per claim 21 Bays et al. is directed to the method further comprises creating an entry in a link table for each cell in the annotated portion, wherein the entry for each cell contains an indication of the annotations (page 2, paragraph 0020, lines 3-6, wherein "link" means "pointer information").

As per claim 22 Bays et al. is directed to the entry for each cell contains an identifier uniquely identifying the record containing the annotation (figure 2; page 2, paragraph 0020, lines 3-6, wherein "link" means "pointer information").

As per claim 24 Bays et al. is directed to a tangible computer-readable storage medium containing a program for associating an annotation with an annotated portion of a first view of data which, when executed by a processor, performs operations comprising:

providing an interface allowing a user to select the annotated portion and to create the annotation, wherein the annotated portion comprises at least two cells visible in the first view of data (page 4, paragraph 0050, lines 7-9, wherein "reference" means "annotation"; page 4, paragraph 0053);;

creating a link to each cell in the annotated portion (page 2, paragraph 0020, lines 1-6);

creating a record containing the annotation and the link to each cell in the annotated portion (page 2, paragraph 0020, lines 1-9).

displaying of a second view of data (figure 2 shows "interface" with icons, rows and columns and different view button; page 3, paragraph 0038, lines 7-9, wherein "second view" means "views");

analyzing the second view of data to identify cells visible in both the second view of data and the annotated portion of the first view of data (figure 2 shows "interface" with icons, rows and columns; page 3, paragraph 0038, lines 10-16); and

providing an indication of the annotation, only if a predetermined set of cells visible in the second view of data are visible in the annotated portion of the first view of data (figure 2 shows "interface" with icons, rows and columns; page 2, paragraph 0017, lines 22-29).

As per claim 26 Bays et al. is directed to providing an interface allowing the user to specify the predetermined set of cells (page 2, paragraph 0022, lines 5-7).

As per claim 27 Bays et al. is directed to a system for creating and displaying annotations associated with views of data, comprising:

a processor (page 3, paragraph 0049, line 3);

an application for displaying views of data (figure 2 shows "interface" with icons, rows and columns; page 4, paragraph 0050, lines 8-9);

a storage medium for storing an annotation database for storing annotation records (page 4, paragraph 0052, lines 16-17);

and an annotation system configured to allow a user to create and annotation for a selected annotated portion of a first view of data displayed by the application, wherein the annotated portion comprises at least two cells visible in the first view of data, create cell links to each cell visible in the annotated portion, and create an annotation record containing the annotation and the cell links, analyze a second view of data displayed by the application to identify cells visible in both the second view of data and the annotated portion of the first view of data, only if a predetermined set of cells visible in the second view of data are visible in the annotated portion of the first view of data (figure 2 shows “interface” with icons, rows and columns; page 3, paragraphs 0027-0032; page 3, paragraph 0038, lines 10-16).

As per claim 29 Bays et al. is directed to the annotation system is further configured to allow a user to specify the predetermined set of cells (page 2, paragraph 0022, lines 5-7).

As per claim 30 Bays et al. is directed to the system further comprises a link table (page 2, paragraph 0020, lines 3-6, wherein “link” means “pointer information”);

and the annotation system is further configured to create an entry in a link table for each cell in the annotated portion of the first view of data, wherein the entry for each cell contains an identification of the annotation (page 2, paragraph 0020, lines 3-6, wherein “link” means “pointer information”; page 4, paragraph 0052, lines 16-17).

Allowable Subject Matter

11. Claims 11, 23 and 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments filed June 21, 2006 have been fully considered but they are not persuasive.

As to the Applicant's response to the question of "second view", the examiner is still unsure of how is it used and for what benefit. Applicant states the examples based on drawings in figures 4A and 4D. Drawing 4D does not exist in the originally submitted drawings, therefore not sufficiently explained.

As to the analysis of second view in regards to teachings of Bays et al. (US 2003/0018632 A1), since the second view has not been explained, the examiner interprets Bays teaching on page 3 paragraph 0038 lines 10-16 as pertinent to the limitation. If annotations are retrieved, if they exist, then they can be filtered and or modified depending on the context of the reader.

The Applicant also states that annotations would be "automatically displayed". This is not a limitation in any claim of the application.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tomasz Ponikiewski whose telephone number is (571)272-1721. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tomasz Ponikiewski
September 7, 2006


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